

**In the Drawings**

Please modify Figs. 1a and 1b as shown in the marked-up-in-red copies of Figs. 1a and 1b enclosed herewith. A revised formal drawing is enclosed for approval by the Examiner.

### **REMARKS**

New claims 10-20 are added. Support for the new claims are provided by exemplary embodiments of the invention in the originally-filed application at, for example, pages 4-5.

The Examiner did not consider reference DE 3425263 which was filed previously with an Information Disclosure Statement and Form PTO-1449 on March 19, 2004. Applicant submits a translated copy of DE 3425263 with a new Information Disclosure Statement and Form PTO-1449. To the extent that the submitted reference listed on the Form PTO-1449 has not already been considered, and the Form PTO-1449 has not been initialed with a copy being returned to Applicant, such examination and initialing is requested at this time.

The drawings stand objected. Applicant has amended the drawings as suggested by the Examiner, and therefore, respectfully requests withdrawal of the objection.

Claims 1 and 3-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Parra, 4,932,778, in view of Colea, 6,537,479. Claims 1, 3-4 and 6-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Thomas et al., 6,729,062, in view of Colea. Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Parra in view of Colea, and further in view of Phillips, 5,414,557. Claim 2 stands rejected under 35 U.S.C. §103(a)

as being unpatentable over Thomas et al. in view of Colea, and further in view of Phillips.

Regarding a *prima facie* conclusion of obviousness, the Examiner is respectfully reminded that “the initial burden is on the examiner to provide some suggestion of the **desirability of doing what the inventor has done.**” MPEP §2142 (8<sup>th</sup> Ed., revision no. 2) (emphasis added). The **desirability** must be found either in the **references themselves** or in the **knowledge generally available to one of ordinary skill in the art** to modify the reference or to combine reference teachings. MPEP §§2142, 2143 (8<sup>th</sup> Ed., revision no. 2) (emphasis added).

Independent claims 1 and 6 stand rejected for obviousness based on two combinations of references: a) Parra and Colea; and b) Thomas and Colea. That is, each combination of art includes combining Colea with the primary reference wherein the Examiner states it is obvious to modify the primary reference by teachings of Colea. The Examiner provides an alleged **desirability** for modifying the respective primary references by Colea, and such desirability is stated as, “for the purpose of eliminating the contaminants occurred during the time of forming a reticle on the optical element” (pg. 4, para 8 and pg. 5 para. 9 of paper no. 06222004). However, pursuant to the above authority, this alleged desirability must be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The problem

of contaminants occurring during the time of forming a reticle on the optical element is not taught or suggested by the references, and therefore, it is inconceivable that the alleged **desirability** for modifying the respective primary references by Colea can be stated to be based on teachings of the references. Moreover, the Examiner has not provided any teachings from any source of a problem of contaminants occurring during the time of forming a reticle on the optical element, and therefore, the alleged **desirability** for modifying the respective primary references by Colea can not be stated to be in the knowledge generally available to one of ordinary skill in the art. Accordingly, since the alleged desirability provided by the Examiner has no basis in the references themselves or in the knowledge generally available to one of ordinary skill in the art as required for a proper *prima facie* case of obviousness, the obviousness rejections against independent claims 1 and 6 are improper and should be withdrawn. Claims 1 and 6 are allowable.

In fact, the only statement to eliminating the contaminants occurred during the time of forming a reticle on an optical element is taught by the Applicant's originally-filed application (pg. 4). That is, the Examiner is relying on Applicant's disclosure for teachings to provide the rejections, and such reliance is improper and contrary to well established law. The Examiner breaks a long held and basic tenet of Patent law stated generally as, the Examiner **can not** rely on the Applicant's disclosure for teachings to provide a rejection, and such is sometimes

referred to as impermissible hindsight reconstruction. The Federal Circuit stated it most succinctly, "[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." *W. L. Gore & Associates, Inc. v Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The M.P.E.P. defines the problem clearly:

To reach a proper determination under 35 U.S.C. §103, the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all the factual information, the Examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person. **Knowledge of Applicant's disclosure must be put aside in reaching this determination**, yet kept in mind in order to determine the 'differences', conduct a search and evaluate the 'subject matter as a whole' of the invention. The tendency to resort to 'hindsight' based upon the Applicant's disclosure is often difficult to avoid do to the very nature of the examination process. However, **impermissible hindsight must be avoided** and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

M.P.E.P. §2143 (8th ed., revision no. 2) (emphasis added). The Examiner presents no reference or references of record for teachings to "a purpose of eliminating the contaminants occurred during the time of forming a reticle on the optical element", except for improperly relying on teachings of Applicant's disclosure. Pursuant to the authority above, such reliance is the insidious

hindsight syndrome that must be avoided, and therefore, the Examiner's rationale (desirability) for the obviousness rejections against independent claims 1 and 6 must fail. The obviousness rejections against claims 1 and 6 should be withdrawn.

Further regarding the alleged motivational rationale (desirability) stated as "a purpose of eliminating the contaminants occurred during the time of forming a reticle on the optical element", Applicant respectfully requests identification of additional prior art or specific teachings within the existing art in a non-final office action which discloses the alleged desirability suggested by the Examiner, or the submission of an affidavit to support the Examiner's rejection, pursuant to MPEP §2144.03 (8th ed.) and 37 C.F.R. §1.104(d)(2). "Assertions of technical facts in areas of esoteric technology must always be supported by citation of some reference" and "allegations concerning specific 'knowledge' of the prior art, which might be particular to a particular art should also be supported." *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418, 420-421 (CCPA 1970) (emphasis added). 37 C.F.R. §1.104(d)(2) states "when a rejection in an application is based on facts within the personal knowledge of an employee of the office, the rejection must be supported by an affidavit when called for by the applicant." The Examiner is relying on the statement to "a purpose of eliminating the contaminants occurred during the time of forming a reticle on the optical element" without any support in the prior art. Without supporting prior art, affidavit or other evidence

that Applicant can rebut, Applicant is denied an opportunity during prosecution to properly respond to the obviousness rejections due to the lack of prior art. According to 37 CFR §1.104(d)(2), Applicant should have the opportunity to contradict or explain such prior art. The lack of prior art to support the Examiner's rejection clearly indicates Applicant's claims are not obvious. Identification of additional prior art or specific teachings within the existing art, or an affidavit, is requested and appropriate. The obviousness rejection against the claims are improper in the absence of such evidence.

Dependent claims 2-5 and 10 depend from independent claim 1, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

Dependent claims 7-9 and 11 depend from independent claim 6, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

For example, dependent claim 2 stands rejected for obviousness based on two combinations of references: a) Parra, Colea and Phillips; and b) Thomas, Colea and Phillips. Claim 2 recites a structure is adapted to the image field curvature of the telescopic sight or binocular telescope, wherein claim 1, from which claim 2 depends, recites said structure is introduced as internal engraving

into said transparent optical part by laser action. However, neither combination of art teaches the recited limitation of claim 2, and therefore, the Examiner adds the following contention to be combined with the teachings of the references to allegedly teach the positively recited limitation, "it is noted that an image made by laser action within an optical element can have any kind of shape/configuration as desired by an operator" (pg. 6, para. 10 and pg. 7, para. 11 of paper no. 06222004). Applicant respectfully requests identification of additional prior art or specific teachings within the existing art in a non-final office action which discloses the alleged teachings suggested by the Examiner, or the submission of an affidavit to support the Examiner's rejection, pursuant to MPEP §2144.03 (8th ed.) and 37 C.F.R. §1.104(d)(2). 37 C.F.R. §1.104(d)(2) states "when a rejection in an application is based on facts within the personal knowledge of an employee of the office, the rejection must be supported by an affidavit when called for by the applicant." The Examiner makes the statement that "it is noted that an image made by laser action within an optical element can have any kind of shape/configuration as desired by an operator" without pointing to any teaching or support for such statement. Accordingly, the rejection based on this unsupported statement can only be based upon the personal knowledge of the Examiner. Without supporting prior art, affidavit or other evidence that Applicant can rebut, Applicant is denied an opportunity during prosecution to properly respond to the obviousness rejection due to the lack of




prior art. According to 37 CFR §1.104(d)(2), Applicant should have the opportunity to contradict or explain such prior art. Identification of additional prior art or specific teachings within the existing art, or an affidavit, is requested and appropriate. Claim 2 is allowable.

Dependent claims 10-11 recite the structure comprises cracking in the at least one transparent optical part. No proper combination of art teaches this positively recited limitation. Each rejection presented by the Examiner is based on a combination of art that includes Colea. However, Colea teaches an invention wherein the **specific intent is to avoid forming cracks** during the engraving of a material (col. 4, Ins. 45-55 and col. 5, Ins. 1-8). That is, Colea provides a teaching away of forming cracks in a material during the engraving. The Examiner is respectfully reminded that teaching away from the art is a *per se* demonstration of lack of obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). Moreover, “[a] prior patent must be considered in its entirety, *i.e.*, as a *whole*, including portions that would lead away from the invention.” *Panduit Corp. v. Dennison Manufacturing Co.*, 810 F.2d 1561, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987) (citations omitted). The Colea patent teaches away from Applicant's invention recited in claims 10-11, and therefore, pursuant to the above authority, is a *per se* demonstration of lack of obviousness. A rejection against claims 10-11 based on a combination of art that includes Colea is not appropriate. Claims 10-11 are allowable.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 10-28-04

By:   
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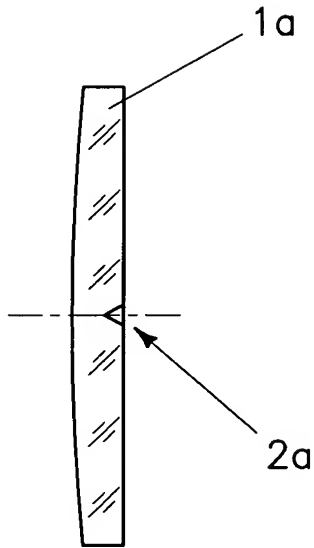


Fig. 1a  
Prior Art

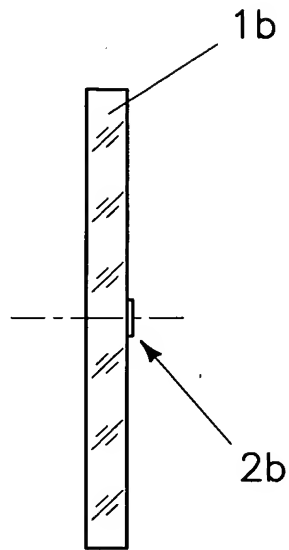


Fig. 1b  
Prior Art

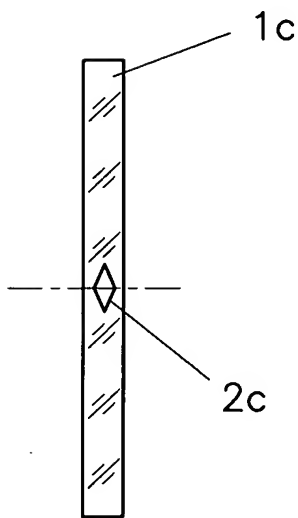


Fig. 2

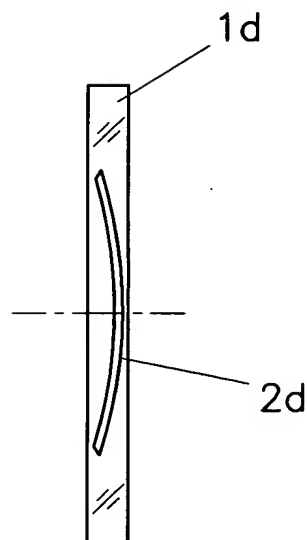


Fig. 3